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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/081,781 | 02/20/2002 | Todd H. Young | 32421 | 2719 |

9629 7590 07/15/2003

MORGAN LEWIS & BOCKIUS LLP
1111 PENNSYLVANIA AVENUE NW
WASHINGTON, DC 20004

EXAMINER

MORAN, KATHERINE M

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3765

DATE MAILED: 07/15/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

EC

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/081,781 | YOUNG, TODD H. | |
| | Examiner | Art Unit | |
| | Katherine M Moran | 3765 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 February 2002 is/are: a) ☒ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

✓ 1. The drawings are objected to because there are two drawings labeled as Figure 5. Please submit new drawings with the second Figure 5-Figure 9 re-labeled as Figures 6-10. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

✓ 2. Claim 15 is objected to because of the following informalities: inserting --bottom portion of the-- before “bucket” in line 17 would more clearly define the position of the user’s fingers.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 2, 4, 5, 7, 8, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Maxwell (U.S. 3,563,237). Maxwell ‘237 discloses the invention as claimed. Maxwell teaches a thumb guard 10,110 comprising an elongated strap formed of flexible, resilient and padded material, with the body defining a tubular, tapered, open-ended, thumb-receiving passageway having a relatively large open end and an opposed, relatively small open end. The strap has a width that does not vary more than by a factor of two. The tubular shape is formed by

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overlapping end segments 16,18,116,118 fixedly secured, folded together, adapted to be folded back, and interconnected to define the thumb-receiving passageway. The guard is configured so that when placed on a thumb by passing the thumb into the passageway through the relatively large open end, portions of the guard proximal the open end cover and thereby protect the metacarpophalangeal joint of the thumb from undue stresses.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3, 6, 9-14, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maxwell '237 in view of Skelton (U.S. 5,092,481). Maxwell discloses the invention substantially as claimed. However, Maxwell does not teach overlapping end segments secured by a plurality of stitches, padded material having a thickness of from about 1/8" to about 1/4", a method of protecting tissues of the thumb and hand while a person holds a paint bucket having a bail comprising providing a tubular, tapered body as disclosed above, inserting the thumb into the passageway through the large open end, and orienting the body with respect to the thumb with portions of the body in generally covering protecting relationship to the metacarpophalangeal joint of the thumb to protect the thumb and joint from undue stresses while the user holds a bucket with the thumb hooked under the bail of the bucket. Maxwell is moot with respect to the thickness of the strap material. The specification does not disclose the critical

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nature of this particular measurement. As such, the ideal thickness measurement of range could have been arrived at through routine experimentation. A thickness of 1/8" to 1/4" would define a strap which is thick enough to provide sufficient interface protection, yet allows for preservation of the user's tactile properties. Maxwell teaches that the ends of the strap are secured by adhesive. Again, the specification does not disclose any particular advantages gained by stitching the end segments and various securing means, including adhesive and stitching, are well known and equivalent in the art. Skelton '481 teaches a method of holding a bucket 14 with a user's thumb positioned adjacent a bail portion 12 and the fingers engaging the bucket as shown in Figure 2. A tubular body 10 with overlapping ends defines a thumb passageway for receiving a user's thumb and engages the bail portion, allowing the bucket to be held in one hand. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to form the strap of Maxwell with a thickness of 1/8" to 1/4" to provide a protective strap which preserves tactile properties. It also would have been obvious to stitch the overlapping end segments to provide a more secure and permanent fastening means. Finally, it would have been obvious to employ the strap of Maxwell to perform the method taught by Skelton, because this would allow a user to securely grasp a bail portion of a bucket and steadily hold the container with one hand.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ferrini (U.S. 5,471,681), Busch (U.S. 5,570,807), Prince (U.S. 5,692,236), Grubich

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(U.S. 5,770,297), Tseng et al. (U.S. 6,049,022), and Bean (U.S. 6,279,168) teach relevant prior art..

Any inquiry concerning this communication or earlier communications should be directed to Examiner Katherine Moran at (703) 305-0452. The examiner can be reached on Monday-Thursday from 8:30 am to 6:00 pm, and alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Calvert, may be reached at (703) 305-1025. The official fax number for the organization where this application is assigned is (703) 872-9302. The after final fax number for this organization where this application is assigned is (703) 872-9303.

Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist at (703) 308-1148.

Kmm

July 9, 2003

A handwritten signature in black ink, appearing to read "K Moran", written in a cursive style.

Katherine Moran

Examiner, AU 3765